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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/463,890

04/28/2000

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06/19/2008

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EXAMINER

SULLIVAN, DANIEL M

ART UNIT

PAPER NUMBER

1636

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/463,890	<b>Applicant(s)</b> KOSZINOWSKI ET AL.	
	<b>Examiner</b> Daniel M. Sullivan	<b>Art Unit</b> 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2008 and 11 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 36, 37 and 40-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36, 37 and 40-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5 May 2008 has been entered.

Claims 36, 37 and 40-70 were considered in the Final Office Action mailed 5 February 2007. Claim 36 was amended in the 5 May submission. Claims 36, 37 and 40-70 are pending and under consideration.

### ***Response to Amendment and Arguments***

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36, 37, 40, 42, 48, 51, 54, 57, 58, and 64-66 **stand rejected** under 35 U.S.C. 102(b) as being anticipated by Messerle et al. (1996) *J. Mol. Med.* 74:B8 (previously made of record). This rejection is maintained for the reasons set forth in the 9 July Office Action beginning at page 3 and herein below in the response to Applicant's arguments.

#### **Claim Rejections - 35 USC § 103**

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 41 **stands rejected** under 35 U.S.C. 103(a) as being unpatentable over Messerle et al. (*supra*). This rejection is maintained for the reasons set forth in the previous Office Actions and herein below in the response to Applicant's arguments.

Claim 43 **stands rejected** under 35 U.S.C. 103(a) as being unpatentable over Tomkinson et al. (1993) *J. Virol.* 67:7298-7306 in view of Messerle (*supra*). This rejection is maintained for the reasons set forth in the previous Office Actions and herein below in the response to Applicant's arguments.

Claim 44 **stands rejected** under 35 U.S.C. 103(a) as being unpatentable over Tomkinson et al. (*supra*) in view of Messerle et al. (*supra*), as applied to claim 43 herein above, and further

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in view of Ehtisham et al. (1993) *J. Virol.* 67:5247-5252. This rejection is maintained for the reasons set forth in the previous Office Actions and herein below in the response to Applicant's arguments.

Claims 45-47, 49, 50, 52, 53, 55 and 56 **stand rejected** under 35 U.S.C. 103(a) as being unpatentable over Messerle et al. (*supra*), as applied to claim 36 herein above, in view of Gage et al. (1992) *J. Virol.* 66:5509-5515. This rejection is maintained for the reasons set forth in the previous Office Actions and herein below in the response to Applicant's arguments.

Claim 59 **stands rejected** under 35 U.S.C. 103(a) as being unpatentable over Messerle et al. (*supra*) in view of Roizman et al. (1985) *Science* 229:1208-1214. This rejection is maintained for the reasons set in the previous Office Actions and herein below in the response to Applicant's arguments.

Claims 60-63 **stand rejected** under 35 U.S.C. 103(a) as being unpatentable over Messerle et al. (*supra*) in view of Roizman et al. (*supra*) and further in view of Chen et al. (1987) *Mol. Cell. Biol.* 7:2745-2752. This rejection is maintained for the reasons set forth in the previous Office Actions and herein below in the response to Applicant's arguments.

Claims 67-70 **stand rejected** under 35 U.S.C. 103(a) as being unpatentable over Messerle et al. (*supra*) in view of Luckow et al. (1993) *J. Virol.* 67:4566-4579 (previously made

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of record). This rejection is maintained for the reasons set in the previous Office Actions and herein below in the response to Applicant's arguments.

*Response to Arguments*

In response to the *prima facie* rejections and arguments of record, Applicant has amended claim 36 to recite that the BAC contains all genes that are essential for the generation of an infectious herpes virus in a host cell. In the remarks filed 5 May 2008, Applicant submits that claims 36, as amended, specifies that the BAC contains those genes that are essential (i.e., necessary and sufficient) for generating an infectious herpes virus and contends that neither of the two individual plasmids described by the Messerle can generate an infectious herpes virus in a host cell because infectious viral progeny can only be obtained by co-transfection of both plasmids. Applicant contends that all of the other claims are free of the art because they depend from claim 36.

These arguments have been fully considered but are not deemed persuasive. As pointed out in the Advisor Action mailed 22 May 2008:

[I]t is... noted that even if the amendment had been entered it does not appear to overcome the rejections of record because the properties of the host cell are not specified. Specifically, the host cell could be any cell, including a packaging cell comprising some genes required for generation of an infectious herpes virus. A BAC containing all genes that are essential for the generation of an infectious herpes virus in a packaging cell would not be required to comprise the entire herpes virus genome. Instead it would only be required to comprise the portion that is not present in the host packaging cell. Therefore, it appears that the BAC claimed in the proposed amendment would be anticipated by or, at least, obvious over the art of record.

The instant application provides no limiting definition of a “host cell”. Therefore, the limitation is construed according its plain meaning as encompassing any cell that might act as a host for the BAC of the claims (i.e., any cell that could be transfected with the BAC). Thus, the host cell of the claims encompasses a host cell comprising genes capable of complementing any deficiencies of a herpesvirus genome comprised by a BAC. For example, the host cell of the claims would include a host cell comprising a first BAC according to the teachings of Messerle et al. which is capable of complementing the deficiencies of the herpesvirus genome comprised by the second BAC of Messerle et al. Therefore, the BACs of Messerle et al. do contain all genes that are essential for the generation of an infectious herpes virus in a host cell because the host cell of the instant claims includes a host cell that also comprises the genes comprised by the complementary BAC.

Applicant’s arguments have been fully considered but are not deemed persuasive in view of the record as a whole. Therefore, the claims stand rejected as anticipated by or obvious over the art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M. Sullivan whose telephone number is 571-272-0779. The examiner can normally be reached on Monday through Friday 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Joseph Woitach, Ph.D. can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel M Sullivan/  
Primary Examiner, Art Unit 1636